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10/506,739	04/14/2005	Yong Kin (Michael) Ong	07082.0013U1	5266
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SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			ROBINSON, KITO R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application No. Applicant(s) 10/506,739 ONG, YONG KIN (MICHAEL) Office Action Summary Examiner Art Unit KITO R. ROBINSON 3692 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 03 September 2004. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-52 is/are pending in the application. 4a) Of the above claim(s) 53-71 is/are withdrawn from consideration. 5) Claim(s) _____ is/are allowed. 6) Claim(s) 1-52 is/are rejected. 7) Claim(s) _____ is/are objected to. 8) Claim(s) _____ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on 03 September 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.

J.S. Patent and Trademark Office PTOL-326 (Rev. 08-06)

1) Notice of References Cited (PTO-892)

Notice of Draftsperson's Patent Drawing Review (PTO-948)

Paper No(s)/Mail Date October 2004, 14 December 2004 & 02 March 2009

Information Disclosure Statement(s) (PTO/SB/08)

Attachment(s)

6) Other:



Application No.

Application/Control Number: 10/506,739 Page 2

Art Unit: 3692

DETAILED ACTION

Status of Claims

- This action is in reply to the Restriction/election filed on 27 February 2009.
- 2. Claims 53-71 have been canceled.
- 3. Claims 1-52 are currently pending and have been examined.

Information Disclosure Statement

The Information Disclosure Statement filed on 18 October 2004, 14 December 2004 & 02 March 2009
has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

- 6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 7. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Claim recites "A method according to claim 1, wherein registration of the user includes the user providing the transaction manager with the user supplied identification code." However, it is unclear when the user supplies the identification code.
- Claim 14 recites the limitation "the user supplied identification code" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3692

9. Claims 11, 12, 14, 20 & 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Claim recites The dependent claims refer to the registration of a user and independent claim 1 refers to a registered user. The registering of a user is not disclosed in the parent/independent claim and since the user is already registered in the parent/independent claim.

- 10. Claims 11, 12, 14, 20 & 21 are recites the limitation "registration of the user" and "the merchant is registered". There is insufficient antecedent basis for this limitation in the claim. The Examiner suggests adding the step of registering a user & merchant to independent claim 1.
- 11. Claims 49 & 50-52 are rejected under 35 U.S.C. 112, second paragraph, No Disclosure or Insufficient Disclosure of the structure, material, or acts for performing the function recited in a claim limitation invoking 35 U.S.C. 112. sixth paragraph

Claim element "means for registering a user..." "means for registering a merchant..." "means for receiving a request..." "means for generating a single use transaction request..." "means for checking validity..." "means for receiving..." and "means for validating..." are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The structure used to register, generate, and validate are not sufficiently described in the disclosure.

Applicant is required to:

- Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph.
- Amend the written disclosure of the specification such that it expressly recites what structure, material, or acts perform the claims function without introducing any new matter (35 U.S.C. 132(a)).

If the Applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, Applicant is required to clarify the record by either:

a. Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing an new

matter (35 U.S.C. 132(a)); or

b. Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification; performing the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(o).

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-47, 48, 50-52 are rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (1-47, 48, 50-52) are not tied to a particular machine or apparatus nor do they execute a transformation. Thus, they are non-statutory.

('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.'). A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Page 5

Application/Control Number: 10/506,739

Art Unit: 3692

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filled in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filled in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- Claims 1-4, 6-15, 18, 19, 23-25, 30, 32, 37-42, 48-52 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Foth et al. US 2004/0103060. hereafter Foth.

As per claim 1, 48, 49 & 50

- providing a transaction manager (see at least the Abstract);
- generating a single use transaction request identification (see at least paragraph 0012)
- the transaction manager relating the transaction request identification to banking information of a registered user (see at least paragraph 0031)
- providing the registered user with the transaction request identification (see at least paragraph 0012):
- the registered user requesting to purchase a product or service having a value from a merchant, the purchase request including providing the transaction request identification to the merchant (see at least paragraph 0013)
- the merchant sending a payment request to the transaction manager for a fund transfer of the value from the user to the merchant, the payment request including the transaction request identification and the value (see at least paragraph 0013);
- the transaction manager checking the validity of the transaction request identification and disabling re-use of the transaction request identification (see at least paragraph 0012):

Application/Control Number: 10/506,739 Page 6

Art Unit: 3692

• and if the transaction request identification is valid, sending an EFT request to a financial

institution to transfer the value in funds from the user to the merchant, the EFT request including

the banking information (see at least paragraph 0012);

checking whether sufficient funds are present in the user's bank account and if sufficient funds

are present, the financial institution performing the transfer according to the banking information

(see at least paragraph 0024)

• the transaction manager receiving confirmation of the transfer from the financial institution and

sending the confirmation to the merchant (see at least claim 16).

for the means plus function see paragraph 0021

As per claim 2

· the transaction manager generates the transaction request identification (see at least paragraph

0012).

As per claim 3, 51 & 52

the transaction request identification is a random number (see at least paragraph 0026).

As per claim 4

the transaction request identification is generated using a formula (see at least paragraph 0026).

As per claim 6

· a combined transaction identification is generated by hatching the transaction manager generated

transaction request identification and a user supplied identification code, the combined

transaction identification being send in the purchase request to the transaction manager (see at

least paragraph 0030).

As per claim 7

 the merchant is provided with the transaction request identification in the form of the combination transaction identification (see at least paragraph 0030).

As per claim 8

 the banking information related to the transaction request identification includes a credit card or debit card number, a card expiry date and a cardholder name (see at least paragraph 0027).

As per claim 9

• the banking information includes a bank account number (see at least claim 74).

As per claim 10

 the banking information may additionally include bank account type and bank account holder information (see at least paragraph 0022).

As per claim 11

 registration of the user occurs prior to the generation of the transaction identification (see at least paragraph 0011 & 0012).

As per claim 12

registration of the user entails creation of a transaction manager user account, wherein the

transaction manager user account includes a transaction manager account number and the

banking information is provided by the user to the transaction manager (see at least paragraph

0011).

As per claim 13

• the transaction manager confirms the further transaction information with the user's financial

institution (see at least paragraph 0030)

As per claim 14

· registration of the user includes the user providing the transaction manager with the user supplied

identification code (see at least paragraph 0030).

As per claim 15

the transaction request identification is related to transaction manager user account information

thereby linking the transaction request identification to the banking information (see at least

paragraph 0026).

As per claim 18

· each relationship of a transaction request identification to the banking information further includes

a transaction manager account number or transaction account alias, transaction limit, and a

transaction limit override password (see at least paragraph 0024).

As per claim 19

the registered user is provided with another single use transaction request identification by the

transaction manager upon request by the registered user (see at least paragraph 0012.) The

PAIN is a one-time use authorization number and it is inherent that the user would request

another PAIN for every transaction.

As per claim 23

. the purchase request includes providing the merchant with the value of the purchase (see at

least paragraph 0013).

As per claim 24

. the user nominates the purchase item and the merchant provides the purchase value (see at

least paragraph 0013).

As per claim 25

· the transaction manager validates the transaction request identification by checking that the

transaction request identification is related to the user's transaction manager account (see at

least paragraph 0013).

As per claim 30

the EFT request to the financial institution is conducted using the credit card or bank account

details, the transfer amount (value of the transfer) and the merchant account details sent to the

financial institution to transfer the funds according to a standard electronic fund transfer system

(see at least paragraph 0023).

As per claim 32

 the confirmation of the transfer sent from the financial institution to the transfer manager is the same as the confirmation message sent from the transaction manager to the merchant (see at

least claim 16).

As per claim 37

confirmation of transfer of funds is sent from the merchant or transaction manager to the user

(see at least claim 16)

As per claim 38

this confirmation is sent in the form of an e-mail message (see at least paragraph 0035).

As per claim 39

• the transaction request identification is issued to the user in an on-line environment, such as via

the Internet (see at least paragraph 0025).

As per claim 40

the transaction request identification is provided to the user by a telephone interface system (see

at least paragraph 0025).

As per claim 41

the transaction identification is issued to the user by sending the transaction identification to a

portable storage device held by the user (see at least paragraph 0029).

As per claim 42

the user can activate transfer of the transaction request identification from the portable device to

the merchant (see at least paragraph 0029).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 16. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - Determining the scope and contents of the prior art.
 - Ascertaining the differences between the prior art and the claims at issue.
 - 3. Resolving the level of ordinary skill in the pertinent art.
 - Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 16, 20-22, & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foth in view of Robinson US 2003/0061172 A1

As per claim 16

Foth discloses the limitations as shown in the rejection of Claim 1 above. Foth does not disclose the limitation of the transaction manager information includes a transaction manager account number, and preferably a transaction manager account expiry date, and a transaction manager account password. However, Robinson, in at least Paragraph 0092 discloses "An additional feature of the present invention comprises an individual enrolling in the system of the invention the ability to register a password that in conjunction with a SID would allow the individual to perform account maintenance of a system account over the Internet from a remote device."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth with the technique of Robinson because it is a quick and easy way to verify the user from remote locations.

Art Unit: 3692

As per claim 20-22

Foth discloses the limitations as shown in the rejection of Claim 1 above. Foth does not disclose the limitation of the merchant is registered with the transaction manager, registration of the merchant entails the transaction manager providing the merchant with a merchant identification and the purchase request sent by the merchant to the transaction manager includes the merchant identification. However, Robinson, in at least Paragraph 0037 discloses "Merchant accounts comprise information useful for authenticating a merchant, associating a merchant with a financial account, and completing transactions. By way of illustration and not as a limitation, a merchant account may comprise a SID, merchant location, and a phone number; a list of terminal ID numbers (TIDs) of the terminals designated to perform system functions; one or more financial accounts; and enrollment and transaction approval/decline parameters.."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth with the technique of Robinson because it is a quick, easy and convenient way to register and verify the merchant identity to the system.

As per claim 26

Foth discloses the limitations as shown in the rejection of Claim 1 above. Foth does not disclose the limitation of the transaction manager account password is provided to authenticate the identity of the user providing the transaction request identification. However, Robinson, in at least Paragraph 0092 discloses "An additional feature of the present invention comprises an individual enrolling in the system of the invention the ability to register a password that in conjunction with a SID would allow the individual to perform account maintenance of a system account over the Internet from a remote device."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth with the technique of Robinson because it is a quick and easy way to verify the user.

Art Unit: 3692

 Claims 5, 17, 27-29, 31, 33-36, 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foth in view of Robinson and in further view of Official Notice

As per claim 5

With regard to the limitation of the transaction request identification is generated using a random number

and a formula. Foth in at least paragraph 0026 discloses the PAIN can be, for example, a randomly or

cryptographically generated number that is linked to information that identifies the transaction for which

the buyer 14 has authorized payment. Foth does not specifically state a random number and a formula.

However, the Examiner takes Official Notice that it is old and well known in the banking arts to generate

transaction numbers by formula and a random number generator.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

 $[combine/modify] \ the \ method \ of \ Foth \ \& \ Robinson \ with \ the \ technique \ of \ \textbf{Official Notice} \ because \ it \ is \ a$

quick, easy and convenient way to generate transaction numbers that are not repeated which reduces the

chances of fraud from predicting the transaction numbers.

As per claim 17

With regard to the limitation of the transaction manager information further includes a transaction

manager account alias. Foth in at least paragraph 0011 discloses the user establishes an account. Foth

does not specifically state a transaction manager account alias. However, the Examiner takes Official

Notice that it is old and well known in the banking arts to assign alias or nicknames to account.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

[combine/modify] the method of Foth & Robinson with the technique of Official Notice because it is a

quick, easy and convenient way to refer to bank accounts and save personal settings.

As per claim 27-29

With regard to the limitation of disabling of the use of the transaction request identification is conducted

by removing the relationship between the transaction request identification and the user's transaction

manager account number, the transaction request identification is deleted from the user's transaction

manager account information and disabling use of the transaction request identification includes the step of adding the transaction request identification to a spent list, the spent list being used to ensure a transaction request identification is not reused; Foth in at least paragraph 0021 discloses Payment service 12 also includes a payment authorization system 22 to generate a one-time authorization number for a transaction requested by the buyer 14 as described below. However, the Examiner takes Official Notice that it is old and well known in the banking arts to have one-time transaction numbers, to delete the one-time transaction numbers from the users account and to place the one-time transaction number in a used transaction number list to ensure they are not reused.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth & Robinson with the technique of **Official Notice** because it is a quick, easy and convenient way to reduce fraud from mishandled transaction numbers, cards and stolen identities.

As per claim 31

With regard to the limitation of the financial institution sends an insufficient funds reply if sufficient funds are not present, whereupon the transaction manager sends an insufficient funds reply to the merchant; Foth in at least paragraph 0024 discloses "payment service 12 can confirm that the account 20 of the buyer 14 has sufficient funds to cover the cost of the transaction (if the account 20 does not include a credit line 32 (FiG. 3))..." However, the Examiner takes Official Notice that it is old and well known in the banking arts to check for insufficient funds and to send a reply if funds are not available.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth & Robinson with the technique of Official Notice because it is a quick, easy way to notify the user of overspending and to notify the merchant to except alternative forms of payment.

As per claim 33

Application/Control Number: 10/506,739 Page 15

Art Unit: 3692

With regard to the limitation of the transaction manager creates a different confirmation message for the merchant; Foth in at least claim 16 discloses "providing confirmation of the providing of funds for payment

to the buyer." However, the Examiner takes Official Notice that it is old and well known in the banking

arts to provide a different confirmation message to the merchant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Foth & Robinson with the technique of Official Notice because it is an

easy and convenient way to notify the transaction has been completed.

As per claim 34

With regard to the limitation of wherein in one embodiment the step of disabling re-use of the transaction request identification includes the formula for generating the single use transaction request

identification including an increment in the next transaction identification request issued; Foth in at least

paragraph 0012 discloses "The PAIN is a one-time use authorization number specific to the transaction.

The PAIN may be cryptographically generated over a sufficiently wide range of integer values such that it

would be difficult for an unauthorized party to guess the number assigned to a transaction with the

attributes previously specified." However, the Examiner takes Official Notice that it is old and well known

in the arts to disable and provide another transaction number by incrementing the number sequence.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

[combine/modify] the method of Foth & Robinson with the technique of **Official Notice** because it is an easy and convenient way to provide multiple transaction numbers.

easy and convenient way to provide multiple transaction numbers

As per claim 35

Foth discloses:

the method of generating the transaction identification includes providing a check sum digit or

character in the transaction request identification (see at least paragraph 0022 & 0037)

As per claim 36

Art Unit: 3692

Foth discloses:

the transaction request identification is a number (see at least paragraph 0012).

As per claim 43 & 44

With regard to the limitation of the portable storage device can store a plurality of transaction request

identifications and a plurality of transaction request identifications may be provided to the user; Foth in at

least paragraph 0029 discloses "Alternatively, access to the payment service 12 could be obtained

utilizing a radio frequency identification tag (RF ID tag) and associated reader or biometric data of the

agent 16 or merchant 18." However, the Examiner takes Official Notice that it is old and well known in

the smart card arts to have a smart card capable of storing a plurality of transaction numbers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

[combine/modify] the method of Foth & Robinson with the technique of Official Notice because it is a

quick, easy and convenient way to provide multiple transaction numbers to the user.

As per claim 45-47

With regard to the limitation of wherein the transaction manager manages a plurality of registered

users each having a plurality of transaction request identifications available for use in making a purchase

or purchases, wherein the transaction manager registers a plurality of merchants and the transaction

manager can conduct electronic transfers between a plurality of financial institutions. Foth in at least

paragraph 0021 & 0022 discloses "Agent 16 may be a third party separate from buyer 14 or may be an

internal agent, such as, for example, an employee, of buyer 14. Payment service 12 maintains one or

more accounts 20 for buyer 14 as described below." However, the Examiner takes Official Notice that it

is old and well known in the arts to have a EFT system capable of conducting transfers with multiple

merchants, users and financial institutions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

[combine/modify] the method of Foth & Robinson with the technique of Official Notice because it is a

quick, easy and convenient way to provide transactions to a wide range of uses, merchants and financial institutions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KITO R. ROBINSON whose telephone number is (571)270-3921. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kito R Robinson/ Examiner, Art Unit 3692

22 April 22, 2009

/Susanna M. Diaz/

Primary Examiner, Art Unit 3692